

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, both the undersigned and John C. Pokotylo would like to thank Examiner Noonan for courtesies extended during a telephone interview on February 5, 2009 (referred to as "the telephone interview"). The telephone interview is summarized here.

Telephone Interview Summary

This statement of the substance of the Interview summarizes the issues discussed during the February 5, 2009 telephone interview. This Interview Summary is presented in the format suggested in MPEP § 713.04 by the Patent Office.

Date of Interview: February 5, 2009

Type of Interview: Telephone

Name of Participants:

- Examiner: Willow Noonan
- For Applicants: John C. Pokotylo
Leonard P. Linardakis

A. Exhibit(s) Shown: None

B. Claims discussed: 1, 3, 39 and 40

C. References Discussed:

- U.S. Patent Application Publication No. US 2002/0010757 ("the Granik publication")
- U.S. Patent Application Publication No. US 2003/0101271 ("the Smith publication")

D. Proposed Amendments discussed:

- Amendments to the claims were discussed to address the Examiner's concerns that the claims recited non-functional descriptive material and were not given patentable weight.

E. Discussion of General Thrust of the Principal Arguments

- The applicants' representatives described the claimed invention, their understanding of the teachings of the Granik and Smith references, and differences between the claimed invention and the teachings of the cited references. Specifically the applicants' representatives described that embodiments consistent with the claimed invention were concerned with tracking the context around the selection (and not just tracking the selection itself) and that the cited references did not teach

or make obvious that *the one or more encoded ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected as a candidate for serving.* In addition, the applicants' representatives noted that claims 3, 39 and 40 further detailed the types of ad properties included in the click URL recited in claim 1, none of which were taught or made obvious by the cited references.

- Regarding claims 3, 39 and 40, Examiner Noonan felt that these claims recited non-functional descriptive material and were not sufficient to distinguish the claims from the cited references. Examiner Noonan noted that the claims should be amended to clearly state the functional relationship of the ad properties recited to the underlying system. The Examiner cited *In Re Gulack* (217 USPQ 401) and *In Re Lowry* (32 USPQ2D 1031) in support of his position.

- Claim amendments were proposed to address the Examiner's concerns regarding the use of the ad properties recited (i.e., charging advertisers using the ad properties, tracking performance using the ad properties, etc.).

F. Other Pertinent Matters Discussed: None

G. General Results/Outcome of Interview

- The Examiner agreed that amending the claims to include the specific use of the recited ad properties included in the click URL (i.e., charging

advertisers using the ad properties, tracking performance using the ad properties, etc.) would overcome the art of record, although further searches would be required. The applicants' representatives agreed to such an amendment subject to approval by the applicants.

Rejections under 35 U.S.C. § 103

Claims 1-3, 20-23 and 39-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0010757 ("the Granik publication") in view of U.S. Patent Application Publication No. 2003/0101271 ("the Smith publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claim 1, as amended, is not rendered obvious by the cited references because neither the Granik publication, nor the Smith publication, either taken alone or in combination, teaches or suggests acts of (A) encoding or decoding one or more ad properties included in a click URL **wherein the one or more encoded ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected as a candidate for serving** and (B) **using the one or more encoded ad properties to perform at least one of (1) tracking the performance of the ad and (2) determining advertiser charges for serving the ad.**

Specifically, during the telephone interview, the applicants' representatives described that embodiments consistent with the claimed invention were concerned with tracking the context around the selection (and not just tracking the selection itself) and that the cited references did not teach or make obvious that **the one or more encoded ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected as a candidate for serving.** The applicants' representatives noted that claims 3, 39 and 40 further detailed the types of ad properties included in the click URL recited in claim 1, none of which were taught or made obvious by the cited references.

During the telephone interview, Examiner Noonan noted that claims 3, 39 and 40 recited non-functional descriptive material and was not sufficient to distinguish the claims from the cited references. Examiner Noonan noted that the claims should be amended to clearly state the functional relationship of the ad properties recited to the underlying system. The Examiner agreed that amending the claims to include the specific use of the recited ad properties included in the click URL (i.e., charging advertisers using the ad properties, tracking performance using the ad properties, etc.) would overcome the art of record, although further searches would be required. As such, independent claim 1 has been amended to further recite the act of **using the one or more encoded ad properties to perform at least one of (1) tracking the performance of the ad and (2) determining advertiser charges for serving the ad.** This

amendment is supported, for example, by page 3, line 30 through page 4, line 14 and page 12, lines 13 and 14.

Thus, in view of the foregoing amendments, claim 1 is not rendered obvious by the Granik and Smith publications for at least this reason. Independent claim 20 has been similarly amended and is not rendered obvious by the Granik and Smith publications for at least the reasons discussed above with respect to claim 1. Since claims 2, 3, 39 and 40 depend from claim 1, and since claims 21-23, 41 and 42 depend from claim 20, these claims are similarly not rendered obvious by the Granik and Smith publication.

Claims 4-9 and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik and Smith publications, further in view of the paper, T. Berners-Lee, et al, "Uniform Resource Identifiers (URI): General Syntax," Network Working Group, Request for Comments: 2396, (August 1998) ("RFC 2396"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 4-9 and 23-28 directly or indirectly depend from claims 1 and 20, respectively. The purported teachings of RFC 2396 would not compensate for the deficiencies of the Granik and Smith publications with respect to claims 1 and 20, as amended (discussed above), regardless of the scope of the purported disclosure in RFC 2396, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 4-9 and 23-28 are not rendered obvious by the cited references for at least this reason.

Claims 10-12, 19, 29-31 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication in view of U.S. Patent Application Publication No. 2003/0035139 ("the Tomita publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 11, 12, 30 and 31 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Next, claims 10 and 29 have been amended to depend from claims 1 and 20, respectively. The purported teachings of the Tomita publication would not compensate for the deficiencies of the Granik publication with respect to claims 1 and 20, as amended (discussed above), regardless of the scope of the purported disclosure in Tomita publication, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 10 and 29 are not rendered obvious by the cited references for at least this reason. Since claims 19 and 38 depend from claims 10 and 29, respectively, these claims are similarly not rendered obvious by the cited references.

Claims 13-18 and 32-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik and Tomita publications, further in view of "RFC 2396". The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since claims 13-18 and 32-37 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

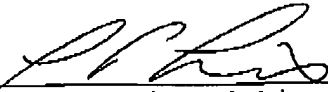
Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a

rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

March 13, 2009

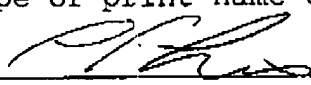

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CERTIFICATE OF FACSIMILE TRANSMISSION

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Leonard P. Linardakis

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Signature

March 13, 2009
Date